

## **AMENDMENTS TO THE DRAWINGS WITHOUT MARKINGS**

### **IN THE DRAWING:**

Fig. 1 has been amended.

## REMARKS

The last Office Action of June 6, 2005 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-5 are pending in the application. Claims 2-4 have been amended. Claims 1 and 5 have been canceled. Claims 6 and 7 have been added. Amendments to the specification have been made. No fee is due.

It is noted that the disclosure is objected to because of applicant's use of reference numerals to designate different elements. Applicant has amended Fig. 1 to label the piston with reference numeral --15-- and the clutch disks with reference numeral --16--. A new drawing sheet is submitted and labeled "Replacement Sheet". Paragraph [0017] of the instant specification has been amended to make it consistent with the changes to Fig. 1. In addition, the specification has been amended to correct an obvious mistranslation with respect to the movement of the transmission parts. The Abstract has also been amended to make it consistent with the specification.

It is further noted that claims 2-4 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,670,265 to Grell et al..

Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,967,046 to Müller.

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,547,060 to Giese in view of Grell et al..

The rejection of claim 5 has becomes moot as a result of the cancellation of claim 5.

Applicant has canceled original claim 1 in favor of claim 4, which has been rewritten in independent form. In drafting claim 4, great care has been taken to

distinguish the present invention from the invention disclosed by the various references. More specifically, claim 4 now sets forth a combination, as suggested by the Examiner, and sets forth the relationship between the outer sleeve and the associated transmission part and their configuration. Applicant asserts that claim 4 has not been narrowed to trigger prosecution history estoppel. See *Salazar v. Procter & Gamble Co.*, 75 USPQ2d, 1369 (stating that introducing claim 7 based on the allowable subject matter of dependent claim 3 of the "149 application was not a narrowing amendment for purposes of patentability and, therefore, does not by itself give rise to prosecution history estoppel).

Claims 2 and 3 have been amended to make them dependent on and consistent with the subject matter of claim 4 and to address the §112, sec. para. rejection with respect to claim 2. Claim 6 has been added to set forth subject matter deleted from claim 4. Claim 7 has been added to set forth the press-fit seat of the inner sleeve in the associated transmission part. Support therefore can be found in the instant specification in [0009] for example.

Applicant respectfully disagrees with the Examiner's rejection of original claim 4 for the following reasons:

Claim 4, as now on file is directed to a combination of radial bearing and transmission parts, whereby the radial bearing, i.a. has an inner sleeve and outer sleeve, whereby the outer sleeve is provided with a coating which contains ZnNi or ZnFe and is applied galvanically before being press-fitted (claim 3) in the associated transmission part, and whereby this transmission part is made of a cast iron material.

The Giese reference describes a radial bearing with an inner ring and an outer ring between which a cage with rolling elements is disposed. Giese is silent as to the construction of the inner and outer rings, let alone the provision of any coating upon the inner ring and/or outer ring. While the Grell et al. reference discloses a steel element, e.g. a rolling bearing component, provided with an electroplated anti-corrosive coating containing zinc-iron or zinc-nickel, Grell et al. as well as Giese are completely silent as to the make up of the transmission part.

To bridge this absence of teaching, the Examiner stated that *"it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the part interacting with the outer sleeve of Giese of cast iron material"*. Applicant believes that this rejection is improper in the context of the present invention and requests a citation or an Examiner's affidavit that provides such citations. As stated by the Federal Circuit in *In re Lee*, 61 USPQ2d, 1434, 1435, "Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.". The Court also stated that "The Board's findings must be documented on the record.". Applicant thus requests a citation or an Examiner's affidavit that provides such citations.

For the reasons set forth above, it is applicant's contention that neither Giese nor Grell et al., nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 4.

As for the rejection of the retained dependent claims, these claims depend on claim 4, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

It should, however, be noted that these dependent claims contain individual patentable features per se. In this connection, applicant wishes to refer e.g. to claims 3 and 7 which set forth the press-fit seat of the sleeves in the associated transmission parts.

Withdrawal of the rejection under 35 U.S.C. §103(a) and allowance of claims 2-4, 6-7 are thus respectfully requested.

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no specific discussion thereof is necessary.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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